

by the Board of Appeals in Appeal No. 2004-2020. Applicant respectfully submits that the Smerdon Jr. Patent fails to correct the 35USC103(a) deficiencies of the cited art of record. The Board of Appeals decision therefore dictates that the 35USC103(a) rejections herein should be withdrawn and that the applicant's claims be allowed.

The grounds for rejecting the claims 1-4, 6-15 under 35USC103(a) is therefore essentially identical to the precise grounds in which the Examiner was already reversed in the parent application Board of Appeals No. 2004-2020 with the exception that the rejection of the claims in this application additionally relies upon US. Patent 6,401,997 by Smerdon Jr. as a secondary reference.

In paragraph 2 of the Office Action, claims 1, 4, 6, 7, 9, 10 and 12 stand rejected under 35USC103(a) as being unpatentable over one of the U.S. Patent 4,834,393 (Feldi) or French Patent Number 2,594,037 (Musslin) either in view of U.S. Patent Number 5,077,870 (Melbye et al hereinafter referred to as Melbye), U.S. Patent Number 6,401,997 (Smerdon Jr. hereinafter referred to as Smerdon) and applicant's alleged admission of the prior art (referred to as AAPA). These are the same as the primary references as were relied upon in the rejection of the parent application. The reliance upon the Feldi patent as a primary reference in the rejection of claims 1, 4, 6, 7, 9 and 10 thus remains essentially identical to the same grounds of rejection relied upon by the Examiner in the appeal of the parent application. Similarly, the reliance upon the Musslin French patent as an alternative primary reference as applied in this Office Action remains substantially identical to the same grounds and issues considered by the Board of Appeals in the appealed claims of the parent application. Similarly, the same grounds and issues upon which the Melbye patent has now been relied upon in the rejection of applicant's claims 1, 4, 6, 7, 9, 10, and 12 herein this application remain substantially identical to those grounds and issues which

were relied upon by the Examiner in the parent application claims before the Board of Appeals, all of which grounds were totally reversed and not sustained in the parent application appeal.

As should be self-evident in this Office Action, the Board of Appeal readily recognized that the alleged grounds for admission of equivalency against interest or prior art admissions (AAPA) by applicant were without any legal merit and so held in its carefully considered opinion. Notwithstanding, the Board of Appeals decision and MPEP guidelines holding completely to the contrary to the position again mistakenly taken herein by the Examiner, the Office Action relies upon an alleged AAPA because there simply does not exist any art recognized authority to factually support the Examiner's unfounded assertions. This constitutes nothing more than relying upon applicant's own findings (not prior art) to provide the rationale and motivation for supplying unknown facts which are clearly not taught by the art of record. Applicant's own teaching and discoveries cannot form the factual basis for predicated a 35USC103(a) rejection. The prior art alone must provide the underlying facts upon which to predicate a 35USC103(a) rejection. The reliance upon applicant's own teachings constitutes nothing more than hindsight reconstruction of the prior art.

The Office Action clearly admits that Feldi, Musslin, or Melbye (as well as Urwin) all fail to disclose the recited hook size parameters such as monofilament diameter, hook height, hook width or hook depth, all of which the Board of Appeals chastised the Examiner for not setting forth the required art founded facts notoriously held to be an essential factor or requirement in order to sustain any 35USC103 rejection. Without factual justification, the 35USC103(a) rejections of record must likewise fail. Unfortunately, the newly cited Smerdon patent bears no relevancy to the nature and character of monofilament hooks or the use of monofilament hooks in the absence of the mating loop fasteners and adhesive backing which adhesively adheres to the

water tube and the bicycle handle bar stem.

Applicant incorporates by reference herein the decision of the Board of Appeals in which the same grounds of rejecting applicant's claims herein was firmly and resoundly reversed by the Board of Appeals. Applicant also incorporates by reference all of the responses including all the papers filed by applicant's attorney in the parent application including those of the appeal before the Board of Appeals as part of this response. There should be no need to argue about any admissions against interest by the applicant since the Board of Appeals carefully considered this issue and clearly held it was not an issue in this case. The Board of Appeals also clearly held that it is the responsibility of the Examiner to establish a prima facie case of obviousness by establishing those art founded facts which would fairly teach and suggest that one of ordinary skill the claimed embodiments of the applicant's invention. This requires that the prior art (not applicant's own teachings) fairly teach and suggest that the unique, very select and highly specific monofilament hooked material as narrowly defined by an average monofilament of at least 8.0 mil, an average hook height of a least 1.85 mm, an average hook width of a least 1.0 mm, and average depth of at least 0.6 mm with the hooks being of a spiral configuration arranged in respective rows of at least 250 hooks per square inch would possess the unexpectedly superior efficacy in tangentially retrieving a grounded tennis ball from a tennis court.

The prior art as cited by the Examiner herein clearly teaches (as acknowledged and held by the Board of Appeals) that what applicant has accomplished herein cannot be accomplished and that such unobvious claimed embodiments were not taught by the cited art. The prior art further provides no motivation, no suggestive teachings nor cogent reason why one of ordinary skill (amongst a myriad of other choices) would be lead to a uniquely distinctive, highly specific and atypical monofilament hooked material which has been solely found by the applicant to

unexpectedly possess superior efficacy in retrieving a grounded tennis ball.

Now, turning more specifically to the newly cited Smerdon patent, applicant respectfully submits that the Smerdon patent adds nothing to the rejection of record nor does it facilitate any further understanding or appreciation by one of ordinary skill as to the claimed inventive contribution of the applicant herein. For some amazing reason, the Examiner alleges that since the Smerdon patent discloses that the adhesive backing of certain hook and loop fasteners maintain good adhesion in wet and warm conditions to a handle bar stem and beverage tube that these obscure teachings must therefore ipso facto be suggestive of the highly specific embodiments of the claimed subject matter herein by the applicant. As with all of the cited references of record, there exists no teachings whatsoever of a hooked monofilament member of a highly specific compositional structure which uniquely and tenaciously engages and retrieves the piles of all grounded tennis balls. The non-sequitur of the hook and loop combination and the adhesive backing of the hook and loop combination as taught by Smerdon solely to equate to the hook element by itself should be self-evident. Smerdon does not use the hook by itself. Smerdon does not use the loop by itself. Smerdon does not use the adhesive backing by itself. Smerdon only teaches and suggests how the adhesive backing of the hook and loop combination will adhesively adhere to the water tubing and bike handlebar stem. The applicant must ask what other than speculative innuendos, abstract and speculative considerations does such a statement bear to any relationship or relevancy whatsoever to the embodiments of applicant's claimed invention herein. As so extensively argued before, there is nothing in Smerdon which remotely teaches or suggests that the monofilament hook by itself, without the loop or without the adhesive backing, should be separately used by itself. This is the same failure that exists in all of the patents relied upon in the 35USC103(a) rejections of record. Certainly, the hook by itself

serves no useful purpose in the invention as disclosed and used by Smerdon. Only the Examiner (knowing precisely what he seeking solely because of applicants own teachings) casting aside all other more germane considerations without any further guidance or motivation, fortuitously concludes Smerdon teaches matter which it does not teach. Analogous to randomly finding isolated words in a dictionary, Smerdon provides no motivation, no suggestion, no rationale as to why such a non-sequitur should be relevant to applicant's invention when viewed in light of the cited non-suggestive prior art teachings.

For reasons unclear from the Office Action, the Office Action relies extensively upon the Col, 12, lines 12-17 teachings:

“The hook and loop fasteners should have a pressure sensitive adhesive backing that till maintain good adhesion in wet and warm conditions. Examples of hook and loop fasteners that have been shown to work well in this application are the 3M Scotchmate TM SJ3526 and SJ3527 industrial fasteners.”

For some unknown reason, the Office Action deems that this non-sequitur as a clear teaching which provides the magic bullet for clearly directing the ordinary artisan unerringly towards applicant's claimed invention. The illogical conclusion of the Office Action assumes that if one skilled in the art is taught that an adhesive backing possesses good adhesion in wet and humid conditions for the hook and loop fastener combination, it naturally follows under the rationale of the Office Action that any hook element by itself will tangentially lift a tennis ball in wet and humid conditions. This is nonsense. The illogical conclusion is made that just because “those hook and loops fasteners maintain good adhesion in wet and warm conditions” (clearly in error because it is the adhesive backing which exhibits good adhesion in the wet and warm conditions), “tennis is generally an outdoor sport”, “tennis tournaments” “are played in wet

and warm conditions” and thereby such irrelevant teachings accordingly teach applicant’s claimed invention herein. The broken logic which reaches such an illogical conclusion defies all of the MPEP guidelines, the case law and statutory mandates of 35USC103(a). The Smerdon teachings strictly pertain to the adhesive backing without any further relationship to either the specific hook and loop characteristics. It is totally in error to conclude that such teachings would ipso facto suggest and teach that the adhesive backing (irrespective of the hook and loop function and purpose) would lead one skilled in the art directly to the monofilament hooked element of applicant’s claimed invention. It should be self-evident that Col. 12 of Smerdon teachings of:

“the hook fastener material 94 is adhered to the side of the handlebar stem where the beverage tube passes beside the stem. A length of loop fastener material 96 is adhered around the circumference of the end of the beverage tube. It is preferable to overlap the ends of the loop section slightly, so that the adhesive bonds to the loop material as well as to the surface of the beverage tube,”

bear no relationship to applicant’s claimed invention herein. Applicant is not claiming an adhesive backing for securing a water beverage tube to a handle bar stem with a hook and loop fastener. Both the hook and loop with the adhesive backing are required by Smerdon Jr. To abstractly isolate the monofilament hook element from the Smerdon Jr. patent hook and loop combination and adhesive backing teachings renders the Smerdon Jr. patent inoperative for its intended purpose and function. Such teachings clearly bear no relevancy to applicant’s claimed invention nor the teachings of Smerdon.

The strained rationale by which the Smerdon patent teachings has been applied to applicant’s claimed invention involves the highest order of hindsight reconstruction of sifting from Smerdon a remote, innocuous and unrelated teaching, which in the context within which it

is found, bears no relevancy whatsoever to applicant's claimed invention or Smerdon. The alleged Smerdon patent teachings, as applied in the Office Action, constitute nothing more than a random gleaning of isolated and disjointed teachings from Smerdon, taken totally out of the context in which they are found and then forcibly combined with other patent teachings in a manner completely untaught and un contemplated by any of the cited patents of record including Smerdon. Smerdon is thus being applied as a reference in a manner completely out of the context in which the Smerdon patent teachings are found and has been applied as disjointed and unrelated teaching to remaining patents of record.

The Examiner is missing the whole point of the Board of Appeals decision in which the Board chastised the Examiner's persistent reliance upon only the claimed hooked elements in each and every cited reference when the references were deemed to teach (as workable combination) the hook and loop fastener combination. None of the secondary references or patents have any relevancy to the use of the hook element as prescribed by applicants claims by itself. All of these references (including Smerdon) rely strictly upon the hook and loop fastener combination. The hook element by itself is an useless and irrelevant teaching within the context of the prior art teachings as relied upon in the 35USC103(a) rejection. Only the hook and loop combination is taught by Smerdon as being useful. Applicant is not claiming hoop and loop fastener combinations but only a precise monofilament hook of a highly specific character and a highly specific functionality which when uniquely utilized in combination with a grounded tennis ball, allows a tangential lifting of all grounded tennis balls from the court. In Smerdon, it is a combination of both hook and loop fastener with the adhesive backing that the Smerdon patent teaches and nothing more. There is no guidance, no suggestion, no direction whatsoever that fulfills the missing art gap and the unknown which existed in the prior art before applicant's

invention.

It is quite obvious that the applicant is now being confronted with a completely subjective rejection of her claimed invention when, in fact, the requirements of 35USC103(a) require that an objective obviousness standard be applied to all inventions. This requires an objective analysis of the claimed invention as a whole and an objective examination of the prior art to ascertain whether or not what is claimed is fairly taught and suggested by the prior art. When so viewed, it should then be recognized that the Smerdon patent bears no relationship, no relevancy, whatsoever to the applicant's claimed invention herein or the cited patents. If it becomes necessary to speculatively rely upon adhesive backing teachings of Smerdon, then to speculatively infer that hook and loop combination may also be relevant to applicant's claimed invention and then to ultimately speculatively infer that only the hook fastener element may be solely relevant to applicant's claims and the combined cited art as inferred in the 35USC103(a) rejection herein, it should become patently evident that the whole basis for relying upon Smerdon rests solely upon a chain of the most highly speculative inferences. Section 35USC103(a) requires facts, not speculative inferences. The same errorful rationale applies to other patents relied upon in the 35USC103 rejections as clearly held by the Board of Appeals.

The Examiner's reliance upon the Smerdon patent to correct the prior art defects of the claims in the appealed parent application must fail for precisely the same reason why the Examiner was completely reversed by the Board of Appeals in the parent application. In the Smerdon patent teachings as relied upon herein, the Smerdon patent clearly teaches that the loop of the hook and loop combination with the adhesive backing as an essential element for the function and use as described by Smerdon in the paragraph bridging columns 11 and 12. The Smerdon patent does not remotely teach or suggest that the hook component in the absence of

loop component will be useful for any purpose, much less the hook and loop fasteners maintains good adhesion in wet and warm conditions. There is nothing in the Smerdon patent which would remotely teach or suggest that the hook fastener element of the hook and loop Scotchmate™ SJ3526 and SJ3527 fastener will work by itself in the claimed embodiments of applicant's invention or even more remotely perform the unexpectedly unique attributes as recited by applicant's claims herein. Only applicant and applicant alone teaches this unique and unexpected embodiment.

The Office Action admits that none of the references disclose the critical recited hook size parameters such as monofilament diameter, hook height, hook width or hook depth, all of which the Board of Appeals was most critical in chastising the Examiner in the parent application appeal. In essence, the Board of Appeals clearly held that in the absence of this showing, there exists no factual justification whatsoever for the 35USC103(a) rejection of record. The current Office Action sidesteps this paucity in prior art teachings by alleging that the Smerdon adhesive backing teachings (which bear no relationship to the recited hook parameters) of both the hook and loop allows for the attachment of a beverage tube to the side of a bicycle handlebar system would of itself fairly suggest applicant's claimed invention. If one of ordinary skill were taught, suggested or remotely motivated by a relevant reference, such a relevant reference or patent (e.g. Smerdon) would appear at a minimum to bear some sort of relationship or teaching concerning the critical and unique parameters of applicant's claimed invention herein. To rely upon a teaching completely irrelevant and unrelated to the critical issues at hand as a basis for forming a 35USC103(a) rejection constitutes the highest order of hindsight reconstruction of the prior art. The applicant alone provides the sole rationale and reasons why such disjointed patent teachings of Smerdon would bear some sort of semblance to applicants

invention. The 35USC103(a) rejection is working on the wrong end of the problem when, in fact, the solution is in the opposite direction and even more specific than that. A host of abstract, speculative inferences and innuendos are required in order to apply Smerdon to the 35USC103(a) rejection of record.

In paragraph 4 of the Office Action, claims 8, 11 and 13-15 stand rejected under 35USC103(a) as unpatentable over Feldi or Musslin in view of Melbye, Smerdon and AAPA and in further view of U.S. Patent No. 4,993,712 to Urwin. This rejection again involves precisely the same issues that were on appeal except for the newly cited Smerdon patent. The Board of Appeals correctly held that the AAPA must fail because this does not constitute a valid basis for sustaining a 35USC103(a) rejection. The prior art (not applicants own teachings) must supply the prima facie facts upon which to base a 35USC103(a) rejection. For reasons pointed out above, Smerdon totally fails to correct the 35USC103(a) art founded defects of the parent application appeal.

When applicant's attorney inquired as to why the Notice of Allowance had not been mailed after the Board of Appeals decision in the parent application, the Primary Examiner indicated that he was so upset about the Board of Appeals decision that he was unable to work the remaining afternoon after receiving the Board of Appeals decision. At that time, without any further art in hand, the Primary Examiner informed the undersigned attorney that he fully intended to have the group Director reopen the case even though it was unknown at that time whether there even existed any factual basis for reopening the prosecution. These events reveal that applicant's invention is not being handled objectively and fairly upon its own merits but rather the prosecution has become a subjective and personal matter. This has done a great injustice to my client who has every reason to believe that her application would be treated fairly

and impartially before the United States Patent and Trademark Office. The applicant is a highly trustworthy and caring person, a credit to her nursing profession. When the Board of Appeals renders a decision to rectify this miscarriage of justice, the prosecution should not have been reopened without first correcting what was always wrong on the appeal. At a minimum, the MPEP guidelines and the Board of Appeals decision should be faithfully followed as impartially required by law.

If there existed a sound factual basis for reinstating the 35USC103(a) rejection, the reopening of the prosecution herein may then have been justified. However, after receiving the new grounds for rejecting the applicant's claims herein, it is self-evident that a decision was first made to reject applicant's claims on new grounds of rejection even before the Smerdon patent or any other reference was uncovered. Even if this was not the case, it should still be self evident that Smerdon teaches nothing further under the mandates of 35USC103(a). Only applicant's own teachings (often erroneously identified as AAPA) provides the sole rationale and logic why such meaningless teachings of Smerdon may intuitively bear some sort of semblance to applicant's claimed invention. It is respectfully submitted that the Board of Appeals will not kindly receive an appeal based upon a rejection which falls within the same errorful ambit as the previously appealed claims. What was lacking in the parent application appeal still remains untaught and un contemplated by Smerdon as well as any of the other cited patents of record.

The Examining Corp is obligated to give full faith and credit to a Board of Appeals decision. The Examining Corps does not have the legal prerogative to blatantly disregard a Board of Appeals decision by reinstating a rejection which poses the same reversal errors as already decided on appeal.

Applicant does not intend to allow the parent application and this application to issue so as to create a double patenting issue. If the claims herein are allowed, applicant will then make her decision as to what application will ultimately issue.

It is respectfully submitted that the rejected claims are allowable in form and clearly patentably distinct over the art of record as promulgated by the Board of Appeals. A fair and impartial reconsideration of the 35USC103(a) rejections of record is respectfully requested and that a Notice of Allowance be promptly issued.

Dated this 12th day of May, 2005.

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